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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,117	12/09/2003	Sugio Makishima	2091-0304P	4321
2292 7590 04/14/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
BEMBEN, RICHARD M				
ART UNIT		PAPER NUMBER		
2622				
NOTIFICATION DATE		DELIVERY MODE		
04/14/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

**Application No.**

10/730,117

**Applicant(s)**

MAKISHIMA ET AL.

**Examiner**

RICHARD M. BEMBEN

**Art Unit**

2622

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 6-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/219,123.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 16 January 2008 have been fully considered but they are not persuasive.
2. Regarding claim 1, Applicant argues that the camera display disclosed by U.S. Patent No 5,966,553 issued to Nishitani et al. (hereinafter "Nishitani") is not capable of displaying a digital image without also displaying printing-specifying information. Referring to c. 8, ll. 5-16, LCD monitor 12 is used as a standard view finder to frame and capture an image. Referring to c. 8, ll. 28-52, print option data is not displayed on the LCD monitor until a photographer operates the print option key. Therefore, Nishitani discloses displaying digital image data with no printing-specifying information onto said display means.

Further, Examiner's reference to c. 6, ll. 40-52 (of Nishitani) discloses processing image data after capture which is sent to the LCD monitor for display *without* any printing-specifying information.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**4. Claims 1, 2, 6, 7 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishitani et al. (US 5,966,553), hereafter “Nishitani”.**

Regarding **claim 1**, Nishitani discloses a digital camera (c. 4, ll. 20-27; Figs. 1-3) comprising:

display means for displaying digital image data as a photographed image, the digital image data being acquired by photographing (c. 4, l. 63 – c. 5, l. 20; Figs. 1-3, “12”);

printing-specifying information setting means for setting printing specifying information for said digital image data, the printing specifying information being used during printing (c. 8, l. 5 – c. 9, l. 50; c. 11, l. 17 – c. 12, l. 8; Figs. 5A-C and 7A-D);

and control means for displaying said digital image data for which said printing-specifying information was set onto said displaying means so that said printing-specifying information corresponds to said digital image data (c. 6, ll. 41-52; Fig. 3, “22”, “44”, “45”; c. 8, l. 5 – c. 9, l. 50; c. 11, l. 17 – c. 12, l. 8; Figs. 5A-C and 7A-D) and for

displaying digital image data with no printing-specifying information onto said display means, such that said digital image data for which said printing-specifying information was set and said digital image data with no printing-specifying information are discriminated from each other when they are displayed on said displaying means (Refer to the **Response to Arguments** and c. 8, ll. 5-52: c. 8, ll. 5-16, LCD monitor 12 is used as a standard view finder to frame and capture an image; c. 8, ll. 28-52, print option data is not displayed on the LCD monitor until a photographer operates the print

option key. Therefore, an image with printing-specifying information, i.e. with the print option data superimposed on the image, and an image without printing-specifying information can easily be discriminated from each other.)

Regarding **claim 2**, refer to the rejection of claim 1 and Nishitani further discloses that said printing-specifying information being used during printing includes a number of print sheets (c. 8, l. 29; c. 9, ll. 28-38; Figs. 5A, 7A, 7D), specification of an index image, printing size (c. 8, l. 28 – c. 9, l. 22; Figs. 5A-C and 7A-D), surface treatment, presence of a white frame, trimming and/or attribute data (claim 2 is examined in the alternative form; c. 8, l. 5 – c. 9, l. 50; c. 11, l. 17 – c. 12, l. 8; Figs. 5A-C and 7A-D).

Regarding **claim 6**, refer to the rejection of claim 1 and Nishitani further discloses that said control means is means for displaying a total number of print sheets on said display means, when said printing-specifying information being used during printing includes a number of print sheets (c. 8, l. 29; c. 9, ll. 28-38; Figs. 5A, 7A, 7D).

Regarding **claim 7**, refer to the rejection of claim 1 and Nishitani further discloses that said control means is means for displaying a number of print frames onto said display means, when said printing-specifying information being used during printing includes a number of print sheets (c. 8, ll. 51; Figs. 5A-C and 7A-D, "55").

**Claim 9** is a method claim corresponding to apparatus claim 1. Therefore, claim 9 is analyzed and rejected as previously discussed with respect to claim 1.

**Claim 10** is a method claim corresponding to apparatus claim 2. Therefore, claim 10 is analyzed and rejected as previously discussed with respect to claim 2.

Regarding **claim 11**, refer to the rejection of claim 9 and Nishitani further disclose displaying a sum of print sheets (claim 11 is examined in the alternative form; c. 8, l. 29; c. 9, ll. 28-38; Figs. 5A, 7A, 7D).

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 4/1, 4/2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishitani in view of Hanzawa (U.S. Patent No. 5,506,661).**

Regarding **claims 4/1 and 4/2**, Nishitani discloses a digital camera comprising a display that displays print information (refer to the rejections of claims 1 and 2).

However, Nishitani does not disclose that control means is means for displaying only the printing-specifying data for which said printing-specifying information was set, in displaying said digital image data onto said display means.

Hanzawa discloses a digital camera comprising a display that displays print information (c. 3, ll. 23-25; c. 4, ll. 40-63; Fig. 2). Hanzawa further discloses that only the printing-specifying data is displayed on said display means (Figs. 2, 5, 6, 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to only display print-specifying data as disclosed by Hanzawa on the display means disclosed by Nishitani in order to simplify the display or save power.

Regarding **claim 8**, Nishitani discloses a digital camera comprising a display that displays print information (refer to the rejection of claim 1). However, Nishitani does not disclose that control means is means for displaying a printing price value corresponding to the number of print sheets onto said display means, when said printing-specifying information being used during printing includes a number of print sheets.

Hanzawa discloses a digital camera comprising a display that displays print information (c. 3, ll. 23-25; c. 4, ll. 40-63; Fig. 2). Hanzawa further discloses that the display displays a printing price value corresponding to the number of print sheets onto said display means, when said printing-specifying information during said printing includes said number of print sheets (c. 4; ll. 40-63; c. 6, l. 3 – c. 7, l. 28; Figs. 2, 5, 6, 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display a printing price value corresponding to the number of print sheets as disclosed by Hanzawa on the display means disclosed by Nishitani in order to inform the customer of the printing price (which is well-known at photo kiosks and the like).

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **RICHARD M. BEMBEN** whose telephone number is (571)272-7634. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye can be reached on (571) 272-7372. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMB

/Nhan T. Tran/

Primary Examiner, Art Unit 2622